

REMARKS/ARGUMENTS

In response to the Office Action of June 26, 2008, applicant has not amended any of the claims in the current application. Further, no claims have been canceled and claim 40 has been added. Applicant respectfully submits that no new matter has been added. Claims 10-40 remain pending in this application. Reconsideration and allowance of the instant application are respectfully requested.

Preliminary Remarks

Representative for applicant wishes to thank Examiners Keaton and Bashore for the courtesies extended to the representative during the telephonic interview of August 5, 2008. The below remarks include applicant's statement of substance of interview in accordance with MPEP § 713.04.

Rejection Under 35 U.S.C. § 101

Claims 31, 34 and 35 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Applicant respectfully traverses.

Applicant notes that claim 31 was first rejected under § 101 in the Office Action of April 17, 2007. Applicant addressed the § 101 rejection in applicant's response to the Office Action of April 17, 2007. In the next Office Action, mailed September 21, 2007, the rejection was removed. As such, applicant reasonably assumed that applicant's argument was persuasive. Such an assumption was confirmed by the Examiners during the interview. However, the Office takes the position that a new interpretation has given rise to this current rejection. Applicant respectfully submits that amended claim 31 is statutory subject matter.

An apparatus claim that contains means-plus-function elements and is supported by structural description in the specification is patentable subject material. *See In re Alappat*, 33 F.3d 1526, 31 USPQ2d 1545 (Fed. Cir. 1994). In finding statutory subject matter in an apparatus claim containing means-plus-function claiming, the *Alappat* Court required the PTO to interpret 35 U.S.C. 112 6th paragraph, for 35 U.S.C. 101 purposes in the same fashion as *In re Donaldson*. *In re Alappat*, 33 F.3d 1526, 31 USPQ2d 1545 (Fed. Cir. 1994); *See In re Donaldson*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994)

(finding the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination). Therefore, the *Alappat* Court found such a claim patentable subject matter because “the claimed invention as a whole is directed to a combination of interrelated elements which combine to form a machine [that performs the desired function] to be displayed on a display means.” *In re Alappat*, F.3d at 1557. Further, the Court held that a digital computer, once programmed, becomes a special purpose computer, a machine specially configured to perform certain tasks, and as such, is statutory subject matter. *Id.* at 1545.

Applicant’s specification makes reference to a machine structure. Fig. 19 and 20 disclose an exemplary mobile telephone and computer architecture that can be programmed to employ the invention’s novel aspects. *See also* Applicant’s Specification, ¶¶[0091] – [0107]. Additionally, ¶[0100] of Applicant’s Specification enumerates a plurality of other computer system configurations that one skilled in the art can program to employ the inventive system. Moreover, the enumerated single or multiprocessor computer systems can be programmed such that the claimed means-plus-function elements are combined to form a machine performing the inventive process to be displayed to a user, thereby satisfying the standard in *In re Alappat*, which finds apparatus claims with means-plus-function elements patentable subject matter. Applicant therefore requests that this rejection be withdrawn.

Rejection Under 35 U.S.C. § 102/103(a)

Claims 10-18, 20-22, 24, 27, 29, 30, 32 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukui *et al.* (US 6940532, hereinafter “Fukui”) and Arbab *et al.* (US 6778192, hereinafter “Arbab”), Ishikawa (US 5506951), and in further view of Martinez *et al.* (US 6147683, hereinafter “Martinez”).

Claims 23, 31, 34 and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukui in view of Arbab and Martinez.

Claim 19 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukui, Arbab, Ishikawa, Martinez as applied to claim 16 and in further view of Eisenberg (US 6331866, hereinafter “Eisenberg”).

Claims 26 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukui, Arbab, and Ishikawa and in further view of MacPhail (US 6924797, hereinafter “MacPhail”).

Claims 37 and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Martinez in view of Ishikawa.

Claim 39 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Martinez as applied to claim 36 in further view of MacPhail.

Claim 36 stands rejected under 35 U.S.C. § 102 as being anticipated by Martinez.

Applicant respectfully traverses these rejections.

Independent Claims 16, 23, 27, 31 and 36

With respect to the feature of a computer readable media configured to allow a second user access to the storage component to change the location of the item of interest as recited in claim 16, the Office Action admits that Fukui fails to teach or suggest such a feature. However, the Office Action alleges that Martinez discloses such this feature. The Office Action supports this contention with col. 3, lines 10-12 and col. 5, lines 8-20 of Martinez. When read in context, col. 3, lines 8-10 (reproduced below) fails to teach or suggest the feature of a computer readable media configured to allow a second user access to the storage component to change the location of the item of interest as recited in claim 16.

Martinez, Col. 3, lines 6-21

Referring to FIG. 1, a computer system 100 in accordance with the preferred embodiment is an enhanced IBM AS/400 computer system. However, those skilled in the art will appreciate that the mechanisms and apparatus of the present invention apply equally to any computer system, regardless of whether the computer system is a complicated multi-user computing apparatus or a single user workstation. As shown in FIG. 1, computer system 100 comprises a processor 110 connected to a main memory 120, a mass storage interface 130, a terminal interface 140, and a network interface 150. These system components are interconnected through the use of a system bus 160. Mass storage interface 130 is used to connect mass storage devices (such as a direct access storage device 155) to computer system 100. One specific type of direct access storage device is a floppy disk drive, which may store data to and read data from a floppy diskette 195.

The cited passage merely describes that the computer system in accordance with the preferred embodiment may be one of a various number of different types of computer systems including a single user workstation and a complicated multi-user computer apparatus and fails to contemplate the features of claim 16. Notably, mere recitation that the computer may be part of a “complicated multi-user computer apparatus” falls short of describing that a second user may access the storage component to change the location of the item of interest as recited in claim 16. Without more, a disclosure of a multi-user system does not necessarily imply that each user of the multi-user system may access the files or programs of another user, much less teaching or suggesting the feature of a computer readable media configured to allow a second user access to the storage component to change the location of the item of interest as recited in claim 16. Moreover, the second cited passage also falls short (reproduced below).

Martinez, Col. 5, lines 8-12

It is also important to point out that the presence of network interface 150 within computer system 100 means that computer system 100 may engage in cooperative processing with one or more other computer systems or workstations on network 170. Of course, this in turn means that the programs and data shown in main memory 120 need not necessarily all reside on computer system 100. For example, one or more portions shown in main memory 120 may reside on another system and engage in cooperative processing with one or more programs that reside on computer system 100. This cooperative processing could be accomplished through use of one of the well known client-server mechanisms such as remote procedure call (RPC).

Martinez, col. 5, lines 8-12 merely describe that cooperative processing with one or more computer systems or workstations on the network is possible. When read in context, Martinez further explains that programs and data need not reside on a single computer system and, instead, may reside on another system. In order to perform as if it the program and data were on a single computer, well known client-server mechanisms such as remote procedure call (RPC) may be utilized. Notably, such a description fails to mention a second user nor does it inherently require a second user, let alone teaching or suggesting that a second user may access the storage component to change the location of the item of interest as recited in claim 16.

At best, Martinez discusses multi-user systems and separately discusses RPC, but even assuming, *arguendo*, that the disclosure of Martinez contemplates a second user having access to the first user's programs or data, such a broad description fails to teach or suggest that *a second user may access the storage component to change the location of the item of interest* as recited in claim 16. As such, applicants respectfully submit that Martinez fails to cure the deficiency of Fukui. Moreover, Arbab and Ishikawa are not alleged to, nor do they cure the deficiency of Fukui. Therefore, even assuming that a combination of Fukui, Arbab, Ishikawa and Martinez is proper, such a combination fails to teach or suggest each and every element of claim 16. Thus, independent claim 16 is allowable.

Independent claims 23, 27, 31 and 36 recite features similar to the distinguishing feature of claim 16 and thus are allowable for reasons similar to those discussed above with respect to claim 16.

Dependent Claims 10-15, 17-22, 24-26, 28-30, 32-35, 37-39

Claims 10-15, 17-18, 20-22, 24-25, 29-30, 32-35, 37-38 ultimately depend on independent claims 16, 23, 27, 31 and 36, respectively, and are at least allowable for at least the same reasons as their respective base claims.

Claim 19 depends on claim 16. However, Eisenberg fails to cure the deficiency of Fukui, Arbab, Ishikawa, and Martinez at least with respect to the feature of a computer readable media configured to allow a second user access to the storage component to change the location of the item of interest as recited in claim 16. As such, even assuming that a combination of Fukui, Arbab, Ishikawa, Martinez, and Eisenberg is proper, such a combination fails to teach or suggest each and every element of the base claim, claim 16. Thus, claim 19 is allowable.

Claims 26 and 28 depend on claims 23 and 27 respectively. However, MacPhail fails to cure the deficiency of Fukui, Arbab and Ishikawa at least with respect to the feature of changing the location of the point of focus based on input from a second user of the plurality of users in the shared environment as recited in claim 23 and the feature of changing the location of the point of focus based on user input from a second user moving the graphical indicator on the scroll bar as recited in claim 27. As such, even

assuming that a combination of Fukui, Arbab, Ishikawa, Martinez, and MacPhail is proper, such a combination fails to teach or suggest each and every element of the respective base claims, claims 23 and 27. Thus, claims 26 and 28 are allowable.

New Claims

Claim 40 has been added. Applicant respectfully submits that support for claim 40 is found at least in ¶[0033] of the Applicant's Specification. No new matter has been added.

CONCLUSION

All rejections having been addressed, applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. If the examiner has any questions or needs any additional information, the examiner is invited to contact applicant's undersigned representative at (202) 824-3153.

Respectfully submitted,

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